

Application No. 10/604,678  
Amendment date December 2004  
Reply to Office Action of September 8, 2004

### **REMARKS/ARGUMENTS**

Independent Claim 1 is amended to include the limitation of Claim 2, and the requirement of upright wall elements. No new matter is believed added. Support for the amendment is found in original claim 2, and in FIG. 2. Claim 2 is deleted without prejudice.

Dependent Claim 5 is amended to include the further limitation of the circumferential recess at the periphery of the second projection, and to correct the text pertaining to the relative movement of the second projections and the base.

Independent Claim 9 is amended to include the limitation of Claim 11, and corrects the text pertaining to the relative movement of the second projections and the base. Claim 11 is deleted without prejudice.

Independent Claim 15 is amended to include the further limitations of a base having an upper surface and a lower surface, and of the circumferential recess at the periphery of the second projection.

Claim 16 is amended to add the limitation of upright wall elements.

Claims 7 and 13 are amended to delete the further limitation that the flexible material be selected from a natural or synthetic rubber. New Claim 21 incorporates the limitation and is dependent to Claim 7.

New Claim 22 depends from amended Claim 15 and adds the further limitation that the upright wall elements comprise first wall elements and second wall elements that project further from the base than the first wall elements.

Claims 1, 3-10, 12-22 remain.

### **Rejections under 35 USC 112**

Claims 2 and 16 were rejected on the grounds that the phrase "wave-like" is vague and indefinite. Applicant's claim amendments have replaced the phrase "wave-like wall elements" with the phrase --wall elements having a wave configuration--.

Claims 6 and 12 were rejected as confusing, vague, and indefinite. Applicants have amended the specification at paragraph 0028 to replace "individual pivots" with -- individual,

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randomly positioned pivot elements --. Support for this amendment is found in the original Claim 6, and in Fig. 2 and Fig. 6. The rejection is rendered moot.

Claims 7 and 13 were rejected as confusing, vague, and indefinite due to the use of the phrase "typically selected from". Applicants have amended Claims 7 and 13 to delete the language objected to by the Examiner.

Claims 8, 14, and 20 were rejected as vague and indefinite, because the phrase "the flexible material" lacks antecedent basis. Applicants have amended the claim dependency to provide the appropriate support.

**Rejections under 35 USC 102(b) as Anticipated by either U.S. 3,722,113 (Birkenstock) or U.S. 3,757,774 (Hatuno)**

The Examiner rejected claims 1, 3, 4, 6-10, 12-15 and 17-20 under 102(b).

Applicants have amended Claims 1 and 9 to incorporate the subject matter of Claims 2 and 11 respectively. Thus, the novelty rejection against these claims is rendered moot.

Applicants have also amended Claim 15 to provide for a base, and to provide that the circumferential recess is formed at the periphery of the second projection, and that the second projections can yield elastically and to displace relative to the base. Applicants contend that neither Hatuno nor Birkenstock disclose lower projections that have circumferential recesses, which allow the lower projection to yield elastically and displace relative to the base. The Applicants contend that the claim as amended distinguishes the references, which neither disclose nor suggest the invention as claimed.

**Rejections under 35 USC 103(a) as Obvious over Huang (US 5839208) in view of either Hatuno, Birkenstock or Wang (2002/0088140).**

The Examiner rejected claims 1-4, 6-10, and 12-20 under 103(a) over Huang in view of Hatuno, Birkenstock or Wang.

U.S. 5,839,208 (Huang) teaches a shoe having a shock-absorbing system having slanted, wave-like elements that are configured to flex with body weight to provide shock absorption. Huang does not disclose or suggest upright wall elements, and does not mention or support massage.

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Hatuno and Birkenstock describe footwear designed to provide massage and provide good foot-feel when walking. Hatuno and Birkenstock do not mention shock absorption.

U.S. 2002/0088140 (Wang) describes footwear that is used in bath areas to allow water to drain completely through the sole and away from the foot surface. Wang does not mention or suggest massage, cushion, or shock absorption. Applicants contend that a person of ordinary skill viewing the Huang reference would not consider the disclosure of the Wang reference as relevant or obvious.

Applicants have amended Claim 9 to incorporate the subject matter of Claim 11. Therefore, the obviousness rejection against Claims 9-14 and 23 is rendered moot.

Applicants contend that the rejection against Claim 1 is rendered moot by Applicant's amendments, and that Claim 1 is patentable over the cited references. This claim as amended requires a heel portion comprising a plurality of laterally-aligned and flexible, upright wall elements having a wave configuration. Applicants contend that the Examiner has failed to state a *prima facie* case of obviousness, since a person of ordinary skill, reading Huang and its purpose of providing shock absorption, would not be motivated to either look for or utilize the massage features of Hatuno or Birkenstock, or the water drainage benefits of Wang. The Examiner states that it would have been obvious to add bottom projections to Huang to increase massage, cushioning, and/or traction. However, Huang does not suggest an unmet need for massage, cushioning, or traction. Thus, a person of ordinary skill, in view of Huang, has no motivation to improve massage, cushioning, or traction. There is also no disclosure or suggestion in Huang to provide wall elements with an upright, wave configuration. Therefore, even if for argument sake one were to combine the cited references, it would not teach or suggestion Applicant's invention.

For the same reasons, Claims 3-8 that depend to Claim 1 are patentable over the cited references.

Claim 9 has incorporated claim 11, and therefore renders the rejection moot. Claims 10 and 12-14 that depend to Claim 9 also are patentable over the cited references

Claim 15 requires a plurality of first projections on the upper surface, and a plurality of second projections on the lower surface of the base, wherein the second projections have circumferential recesses about their periphery, and yield elastically and are displaced relative to the base. Applicants have not found any description in Huang, Hatuno, Birkenstock or Wang

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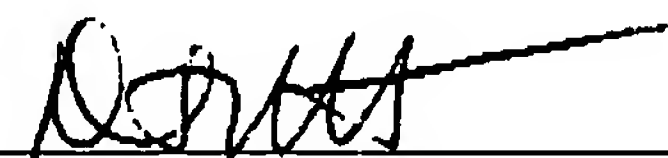
that discloses or suggests projection on one surface of the base that have a circumferential recess that allows the projections to yield elastically relative to the base. Applicants note that the Examiner had indicated that original claims 5 and 11 would be allowable. Applicants contend that the limitations of Claim 15 with respect the second projections and the circumferential recess are likewise allowable.

In view of the amendments made to the claims, and the arguments presented herein, Applicants contend that the present claims patentably distinguish the references of record, and respectfully request an early notice of allowance.

Respectfully submitted,

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